

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 7-8, and 36-39 are pending in the application, with 1 and 36 being the independent claims. Claims 10, 22, and 35 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claims 1, 7, and 8 have been amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Restriction Requirement

In the Office Action, the Examiner stated that claims 2-4, 11, and 23 do not read on the elected species. Thus, the Examiner has withdrawn these claims from consideration. Applicants assert that claim 1 and 22 are generic claims. Accordingly, applicants assert that claims 2-4, 11, and 23 should be brought back into the instant application if independent claims 1 and 22 are found allowable. *See* MPEP 809.04.

Objection to the Specification

In the Office Action on page 3, the Examiner objected to the specification because of various informalities. Applicants have amended paragraphs 3, 36, 66, 69, 72-75, and 79 to address these informalities. The Examiner also stated that paragraph 36 should be amended to include (e.g., see Fig. 2B) following "220." However, paragraph 36 does not include "220."

On page 3 of the Office Action, the Examiner objected to the specification because of informalities related to reference labels in the Figures. Applicants have amended paragraphs 39, 66, and 75 and Figures 1B and 8 to address these informalities. For example,

reference labels 116 was removed from Figure 1B and reference label 808 was removed from Figure 8.

Regarding Fig. 5B, Applicants submit that the reference labels in Fig. 5B can be found in prior Figures, namely Fig. 5A, and these reference labels are discussed in specification in relation to FIG. 5A in paragraphs 49-55.

Regarding Fig. 7, the specification states in paragraph 65 that "Capacitor 706 is a one picofarad capacitor coupled approximately 425 mils from balun input 110." Therefore, the "425" in FIG. 7 represents the distance of the capacitor 706 from the balun input 110 and is discussed in the specification.

Furthermore, the disclosure was objected to because various figures (5B, 8, 10, 11, and 12) include dimensions in the drawings that are not listed in the specification. Applicants submit that it is not necessary to recite dimensions listed on a drawing in the specification, because the dimensions are for labeled elements in the drawing, and the labeled elements are recited in the specification. (For example, labeled element 544 has a dimension 240 in FIG. 5B, and element 544 is mentioned in paragraph 50.) Reciting the dimensions again in the specification would be redundant.

Objection to the Claims

In the Office Action, the Examiner objected to claims 1, 7, 8, and 22 due to matters of form. Applicants have amended these claims to improve their form as suggested by the Examiner.

Objections to the Drawings

On page 3 of the Office Action, the Examiner objected to the drawings based on various matters of form. Applicants have amended Figures 1B, 2A, 2B, 4B, 5B, and 13 to improve their form as suggested by the Examiner. As part of the objection, the Examiner objected to Figure 10 stating that reference label 1006 needed to be provided. Applicants submit that Figure 10 includes reference label 1006.

Rejections under 35 U.S.C. § 112

The Examiner rejected claim 22 under 35 U.S.C. § 112, first paragraph. The Examiner stated that "while being enabling for means for reducing a physical dimension of said metal traces through the use of coupling capacitor as disclosed at paragraph 0054 of the specification, [the specification] does not reasonably provide enablement for all other possible 'means for reducing a physical dimension of said metal traces'." Applicants respectfully disagree with this understanding of 35 U.S.C. § 112, first paragraph.

35 U.S. C. §112 does not require a specification disclose all possible means. *See generally*, M.P.E.P. 2181. In fact, 35 U.S.C. §112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure ... described in the specification and equivalents thereof." As pointed out by the Examiner, the specification provides a corresponding structure in paragraph 54. Furthermore, it would be impossible for the applicant to list every possible means for performing a function, as this rejection seems to call for. Based on the foregoing argument, applicants submit that claim 22 meets the requirements of 35 U.S.C. §112 and respectfully request that the rejection be withdrawn.

Rejections under 35 U.S.C. § 102

Claim 22 was rejected under 35 U.S.C. § 102(b) as being anticipated by Gu, U.S. Patent 5,697,088 (Gu). Applicants traverse this rejection.

To anticipate a claim, every element of the claim must be found or inherently described in a single reference. M.P.E.P 2131. As the Examiner correctly points out, Gu discloses capacitors connected to transmission lines that are described as "tuning elements". (Col. 3, lines 65-68) However, Gu does not disclose a "means for reducing a physical dimension of said metal traces", and there is no indication that the capacitors in Gu are configured to perform this function. For instance, it is possible that the Gu capacitors provide tuning by some other means that does not anticipate the claimed recitation, such as lengthening the physical dimension of the metal traces, which is the opposite of the claimed recitation. When a reference is silent about an asserted characteristic, the gap may be filled

with extrinsic evidence making clear that the missing descriptive matter is necessarily present in the thing described in the reference. M.P.E.P 2131.01. However, the Office Action cites no evidence that it is inherent that Gu includes "means for reducing a physical dimension of said metal traces." Therefore, Applicants submit that Gu fails to teach every element of claim 22, and therefore does not anticipate claim 22. Therefore, it is requested that this rejection be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 103

In the Office Action, the claims 1, 7, 8, 10, 22, 35, and 36-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiroshima *et al*, U.S. Patent 6,535,077 (Hiroshima) in view of Gu. Claims 10 and 35 have been canceled by the above amendment. Therefore, the rejection as to claims 10 and 35 has been rendered moot. Applicants respectfully traverse the rejection as to claims 1, 7-8, 22, and 36-39.

To establish prima facie obviousness, all the claim limitations must be taught or suggested by the cited art. M.P.E.P 2143.03. Applicants submit that the combination of Hiroshima and Gu does not teach or suggest capacitively coupling a plurality of metal traces to ground *so that all the metal traces in the device have physical lengths less than one-quarter wavelength*. As discussed above, Gu does not teach these features, and Hiroshima does not cure this defect.

Therefore, Applicants respectfully submit that the combination of Hiroshima and Gu fails to teach or suggest all the features of amended independent claim 1, original independent claim 22, or original independent claim 36. Applicants therefore request that the Examiner reconsider and withdraw this rejection. Dependent claims 7-8, and 37-39 are patentable for at least the above reasons.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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Date: 11/5/03

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